

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

By the present amendment, Claims 39-58 are added and Claims 20-38 are canceled without prejudice or disclaimer. Support for the present amendment can be found in originally filed specification, for example, at page 7, line 13 to page 20, line 21 and in the corresponding Figures. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 24-27 were rejected under 35 U.S.C. § 112, first paragraph; Claims 20-38 were rejected under 35 U.S.C. § 112, second paragraph; Claims 20-23, 28-30, and 33-36 were rejected under 35 U.S.C. § 102(b) as anticipated by Hodgson (U.S. Patent No. 3,645,835); Claims 24-28, 31, and 32 were rejected under 35 U.S.C. § 102(b) as anticipated by Rollins et al. (U.S. Patent No. 5,340,648, hereinafter “Rollins”); and Claims 37 and 38 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson in view of Clavin (U.S. Patent No. 4,653,483).

In response to the rejections in the outstanding Office Action, it is noted that Claims 20-38 are canceled. Thus, it is respectfully submitted that these rejections are moot.

New Claims 39-58 are added by the present amendment. Support for the present amendment can be found in the originally filed specification, for example, at page 7, line 13 to page 20, line 21. Thus, it is respectfully submitted that no new matter is added.

Claim 39 recites:

A double eyelid forming article of manufacture for forming a fold on an eyelid of a user, comprising:

a resiliently stretchable elongate tape member configured to adhere to the eyelid in a stretched state along a longitudinal direction to form a double eyelid, wherein

the tape member includes a first surface and a second surface to elongate consistently along the entire longitudinal

direction of the tape member while these surfaces are oppositely faced to each other,

the first surface and the second surface each have a pair of side edges that consistently elongate along the entire longitudinal direction of the tape member,

the individual side edges of the first surface and the second surface are each in linear forms in parallel to each other along the whole longitudinal direction of the tape member when the tape member is in an unstretched state,

cross sections of the first surface and the second surface perpendicular to the longitudinal direction of the tape member each have a flat form along the entire longitudinal direction of the tape member when the tape member is in the unstretched state,

the cross sections each have a uniform form along the whole longitudinal direction of the tape member when the tape member is in the unstretched state,

***the first surface and the second surface each have an adhesive layer covering an entirety of the first surface and the second surface,***

the tape member has a consistent and integral form made from a synthetic resin material along the entire longitudinal direction, and

***the tape member in a state stretched along the longitudinal direction has a resilient shrinkability larger than tension of skin on the eyelid and also has a sufficient width and a sufficient length for forming a fold on the eyelid by adhering to the eyelid while the tape member is in the stretched state and subsequently recoiling back toward the unstretched state.***

It is respectfully submitted that the references cited in the outstanding Office Action do not disclose or suggest every feature recited above. Although the references in the outstanding Office Action were cited to reject canceled Claims 20-38, as new Claims 39-58 are directed to similar subject matter as that previously recited in canceled Claims 20-38, Applicant will discuss how new Claims 39-58 patentably define over these references.

Hodgson describes a surgical drape including a backing material 2 and an adhesive 4.<sup>1</sup> Further, Hodgson describes that the adhesive 4 “may be continuous or discontinuous on one surface of the backing material 2.”<sup>2</sup> Additionally, as shown in Figure 7, two edges 24 of the backing material are left uncoated by adhesives.

However, it is respectfully submitted that Hodgson does not disclose or suggest “the first surface and the second surface each have an adhesive layer covering an entirety of the first surface and the second surface . . . and the tape member in a state stretched along the longitudinal direction has a resilient shrinkability larger than tension of skin on the eyelid and also has a sufficient width and a sufficient length for forming a fold on the eyelid by adhering to the eyelid while the tape member is in a stretched state and subsequently recoiling back toward the unstretched state,” as recited in new Claim 39.

Instead, Hodgson describes that the adhesive 4 is located on *one surface* of the backing material 2. Thus, Hodgson does not disclose or suggest that the adhesive 4 covers *an entirety of two surfaces*. Further, although Hodgson describes that the elastic backing material can produce wrinkles in the skin,<sup>3</sup> it is respectfully submitted that Hodgson does not disclose or suggest that the elastic backing material has a resilient shrinkability larger than tension of the skin on the eyelid or that the elastic backing material has a sufficient width and a sufficient length for forming a fold on the eyelid.

Therefore, it is respectfully submitted that Hodgson does not disclose or suggest every feature recited in new Claim 39. Thus, it is respectfully submitted that new Claim 39, and all claims dependent thereon, patentably define over Hodgson.

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<sup>1</sup> See Hodgson, at column 10, lines 27 and 28 and Figure 7.

<sup>2</sup> See Hodgson, at column 9, lines 58-61.

<sup>3</sup> See Hodgson, at column 10, lines 37-40.

Rollins describes an adhesive-wrapped elastic strand 10 including a threadlike elastic strand 12 having a filament of adhesive 14 helically wrapped thereon.<sup>4</sup> Thus, as can be seen in Figure 1, the adhesive 14 does not cover the entire surface of the elastic strand 12.

However, it is respectfully submitted that Rollins does not disclose or suggest “the first surface and the second surface each have an adhesive layer covering an entirety of the first surface and the second surface . . . and the tape member in a state stretched along the longitudinal direction has a resilient shrinkability larger than tension of skin on the eyelid and also has a sufficient width and a sufficient length for forming a fold on the eyelid by adhering to the eyelid while the tape member is in the stretched state and subsequently recoiling back toward the unstretched state,” as recited in new Claim 39.

Instead, as discussed above, Rollins does not describe that the adhesive 14 covers an entirety of the elastic strand 12. Additionally, Rollins does not describe that the adhesive wrapped elastic strand 10 has a resilient shrinkability larger than tension of skin on the eyelid or that the strand 10 is a sufficient width and a sufficient length for forming a fold on the eyelid.

Therefore, it is respectfully submitted that Rollins does not disclose or suggest every feature recited in new Claim 39. Thus, it is respectfully submitted that new Claim 39, and all claims dependent thereon, patentably define over Rollins.

Clavin describes an adhesive strip 32 configured to hold the skin of the upper eyelid 10 which is pulled gently down over the adhesive strip 32 to reduce bagging of the upper eyelid 10.<sup>5</sup> Thus, Clavin describes that the adhesive strip 32 is first placed on the eyelid 10, and then a user folds the eyelid 10 over the adhesive strip 32.

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<sup>4</sup> See Rollins, at column 3, lines 21-24 and Figure 1.

<sup>5</sup> See Clavin, at column 4, lines 26-35 and Figures 6-9.

However, it is respectfully submitted that Clavin does not disclose or suggest “the tape member in a stretched state along the longitudinal direction has a resilient shrinkability larger than tension of skin on the eyelid and also has a sufficient width and a sufficient length for forming a fold on the eyelid by adhering to the eyelid while the tape member is in a stretched state and subsequently recoiling back towards the unstretched state,” as recited in new Claim 39.

Instead, as discussed above, it is respectfully submitted that Clavin describes that the adhesive strip 32 is placed on the upper eyelid 10, and then the user folds the eyelid 10 onto the adhesive strip 32. Thus, Clavin is silent regarding any resilient shrinkability of the adhesive strip 32 to overcome tension of skin on the eyelid 10. Additionally, it is respectfully submitted that Clavin does not describe that the tape member is configured to adhere to the eyelid in a stretched state and then recoil back toward an unstretched state while maintaining adherence to the eyelid 10.

Additionally, it is respectfully submitted that the above-noted feature of Claim 39 is not an intended use, but instead recites structural properties of the tape member. Thus, it is respectfully submitted that such a feature should be given patentable weight.

Therefore, it is respectfully submitted that Clavin does not disclose or suggest every feature recited in new Claim 39. Thus, it is respectfully submitted that new Claim 39, and all claims dependent thereon, patentably define over Clavin.

Independent Claims 45 and 51, while directed to alternative embodiments, recite features similar to those discussed above with respect to independent Claim 39. Therefore, for at least the reasons discussed above with respect to new Claim 39, it is respectfully submitted that independent Claims 45 and 51, and all claims dependent thereon, patentably define over the cited references. Thus, for at least the reasons discussed above, it is respectfully submitted that new independent Claims 39, 45, and 51, and all claims dependent

thereon, patentably define over the cited references, either alone or in any proper combination thereof.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.


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